UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/300,320	04/27/1999	JOHN ANDREW COOK	AT9-99-159	4309

7590   12/03/2001

DUKE W YEE
CARSTENS YEE & CAHOON LLP
PO BOX 802334
DALLAS, TX   75380

EXAMINER
HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 12/03/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _Amendment A, 9/17/01_ .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-31_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-31_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____ .

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims

1.   Amendment A, indicates that claims 8-11 and 23-26 are cancelled. However, the

Amendment does not support this cancellation. In addition, there are errors in the numbering of

the claims (e.g. 11 and 12) and the indications of claims that are unchanged (e.g. 31). Because of

the above, Examiner has reproduced the initial office action as a First Office Action with new

prior art and respectfully requests Applicants to send in a correction to Amendment A.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8-21 and 23-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by

Hyde-Thomson (US 5,557,659).

As to claims 1,16, with respect to Figure 17, **Hyde-Thomson** teaches a method in a data

processing system for processing voice messages, the method comprising the data processing

system implemented steps of:

recording a voice message (Col. 17, lines 10-17);

responsive to recording of the voice message, automatically inserting an attachment (an

indicator) into a text message indicating a presence of a voice message (Col. 17, lines 19-28);

responsive to recording the voice message, automatically appending the voice message

to the text message to form an appended voice message (Col. 17, lines 19-28); and

sending the text message with the appended voice message (Col. 17, lines 25-28).

As to Claims 2,17, **Hyde-Thomson** teaches the method of claim 1 further comprising:

receiving the text message to form a received text message (Col. 16, lines 46-55);

parsing the received text message for a presence of an attachment (an indicator) indicating

that the received text message is a voice message (Col. 16, lines 55-60); and

responsive to a presence of the indicator, presenting controls to listen to the voice message

(Col. 16, lines 60-66).

As to Claims 3,9,12,18,24 and 27, **Hyde-Thomson** teaches the method of claim 1, wherein the

received text message is an electronic mail message (Figure 17, label 1720).

As to claims 4,19, **Hyde-Thomson** teaches the method of claim 1, wherein the indicator is a text

string (Figure 17, label 1727).

As to Claims 5-6 and 20-21, **Hyde-Thomson** teaches the method of claim 1, wherein the data

processing system is a personal computer (Figure 17 and Col. 5, lines 48-53).

As to Claims 8,23,31, with respect to Figure 17, **Hyde-Thomson** teaches a method in a data processing system for sending voice messages, the data processing system comprising the computer implemented steps of:

creating a voice message (Col. 17, lines 10-17);

responsive to creating the voice message, automatically inserting an attachment (identifying string) into a text message identifying a presence of the voice message (Col. 17, lines 19-28);

responsive to creating the voice message, automatically appending the voice message to the text message (Col. 17, lines 19-28).

As to Claims 10,25, with respect to Figure 17, **Hyde-Thomson** teaches a method in a computer for receiving a voice message, the method comprising:

receiving a text message (Col. 16, lines 46-55);

parsing the text message for an identifying string (Col. 16, lines 55-60);

identifying a presence of a voice message associated with the text message (Col. 16, lines 55-60); and

responsive to the presence of the identifying string, displaying the text message as a voice message in a message list (Figure 17, label 1721).

As to Claims 11,26, **Hyde-Thomson** teaches the method of claim 10 further comprising:

responsive to a presence of the identifying string displaying controls for presenting the voice message (Figure 17).

As to Claims 13,28, **Hyde-Thomson** teaches the method of claim 11, wherein the controls

include a play control, a rewind control, and a fast forward control (Figure 17, labels 1709, 1706

and 1710).

As to Claims 14,29, with respect to Figure 17, Hyde-Thomson teaches a messaging system for

use in a data processing system, the messaging system comprising:

a graphical user interface, wherein the graphical user interface provides selections for

user input to create and send voice messages (Figure 17); and

a message processing mechanism, wherein the message processing mechanism has a

plurality of modes of operation including:

record (a first mode) of operation in which the message processing mechanism waits

for a user input;

tape recorder (a second mode) of operation, responsive to a user input in the first

mode of operation to record a voice message, in which the message processing mechanism stores

voice data in a file (Col. 17, lines 13-16);

mail (a third mode) of operation, responsive to a user input in the first mode of

operation to select a recipient for the voice message, the message processing mechanism receives

a selection of a recipient for the voice message (Figure 17); and

e-mail (a fourth mode) of operation, responsive to a user input in the first mode of

operation to send the voice message and to a presence of a recipient for the voice message, in

which the message processing mechanism creates a text message, inserts a identifying string,

identifying a presence of the voice message in the text message, appends the file to the text

message, and sends the text message to the recipient (Col. 17, lines 21-28).

As to Claims 15,30, with respect to Figure 17, Hyde-Thomson teaches the messaging system of

claim 14, wherein the message processing mechanism further includes:

Receive (a fifth mode) of operation in which the message processing mechanism waits

for a receipt of a text message (Figure 17, label 1721);

Play (a sixth mode) of operation, responsive to receiving a text message, in which the

message processing mechanism parses the text message to determine whether an identifying

string identifying a presence of a voice message is present (Figure 17, label 1702); and

Attachment (a seventh mode) of operation, responsive to a presence of the identifying

string, in which the message processing mechanism causes the graphical user interface to display

the message as a voice message in a message list (Figure 17, labels 1727).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims

under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35

U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 7,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hyde-Thomson**

in view of **Pepe et al.** (US 5,742,905).

As to Claims 7,22, **Hyde-Thomson** teaches the method of claim 1.

    Hyde-Thomson does not teach the following limitation:

        "wherein the data processing system is a personal digital assistant"

    Pepe teaches the limitation (Figure 1, label 30 and Col. 1, lines 36-38). Having the cited

art at the time the invention was made, it would have been obvious to one of ordinary skill in the

art to add PDA capability to **Hyde-Thomson's** invention for accommodating mobile subscribers

as taught by **Pepe's** invention in order to provide communications to users anywhere and at

anytime.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Logan et al. (US 5,721,827) teach a personalized information distribution system.

Lumelsky (US 6,246,672) teaches receiving e-mails with voice attachments.

8. Any response to this action should be mailed to:

> Commissioner of Patents and Trademarks
> Washington, D.C. 20231
> **or faxed to:**

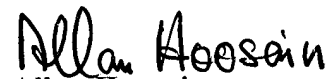> (703) 872-9314, (for formal communications intended for entry)

Or:

> (703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Allan Hoosain
Primary Examiner
11/29/01